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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,585	10/23/2001	Mark A. Kirkpatrick	60027.0071US01	4842
39262	7590	09/03/2004	EXAMINER	
BELLSOUTH CORPORATION P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			YUN, EUGENE	
			ART UNIT	PAPER NUMBER
			2682	

DATE MAILED: 09/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/044,585

Applicant(s)

KIRKPATRICK, MARK A.

Examiner

Eugene Yun

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/26/2004 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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3. Claims 1-9, 11-17, 19, 22, and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Fintel (US 6,704,580).

Referring to Claim 1, Fintel teaches an apparatus 8 (fig. 1) for providing a gateway between one or more wired telephones 18 (fig. 1) and a wireless telephone network 30 (fig. 1) wherein each of said one or more telephones are directly connected to a wired home telephone network 16 (fig. 1) without modification, the apparatus comprising:

- a wireless radio 14 (fig. 1) operative to communicate with said wireless telephone network over a wireless communication link;

- a wired telephone interface 18 (fig. 1) electrically coupled to said one or more wired telephones; and

- a controller, said controller operative to:
 - detect an incoming telephone call at said wireless radio (see col. 6, lines 21-26),
 - provide a ring signal through said wired telephone interface operative to ring said one or more wired telephones in response to detecting said incoming telephone call (see col. 6, lines 39-43), and

- in response to determining that a one of said one or more wired telephones has been placed in a off hook state, to establish a communications channel between said wired telephone interface and said wireless radio, thereby permitting said incoming telephone call to be received on said one of said wired telephones placed in an off hook state (see col. 6, lines 49-60), wherein said apparatus maintains a connection to said

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wireless telephone network while receiving incoming telephone calls via a wired telephone network (see col. 7, lines 15-25).

Referring to Claim 6, Fintel teaches a method for providing a gateway between a wired telephone 18 (fig. 1) directly connected to a wired home telephone network 16 (fig. 1) and a wireless telephone network 30 (fig. 1), comprising:

detecting an incoming wireless telephone call over said wireless telephone network (see col. 6, lines 21-26);

providing a ring signal to said wired telephone in response to detecting said incoming call (see col. 6, lines 39-43);

determining whether said wired telephone has been placed in an off hook state in response to said ring signal (see col. 6, lines 49-53); and

in response to determining that said wired telephone has been placed in an off hook state, converting said incoming wireless telephone call to a format compatible with said wired telephone and converting signals received at said wired telephone to a format compatible with said wireless telephone network, thereby permitting said incoming telephone call to be received and conducted on said wired telephone (see col. 6, lines 54-60),

wherein said gateway maintains a connection with a wired telephone network and said wireless telephone network even when receiving an incoming telephone call over said wired telephone network (see col. 7, lines 15-25).

Referring to Claim 11, Fintel teaches an apparatus 8 (fig. 1) for providing a gateway between one or more wired telephones and a wireless telephone network 30

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(fig. 1) wherein said one or more wired telephones 18 (fig. 1) are directly connected to a wired telephone network 16 (fig. 1), comprising:

- a wireless radio operative 14 (fig. 1) to communicate with said wireless telephone network over a wireless communication link;

- a wired telephone interface 18 (fig. 1) electrically coupled to said one or more wired telephones;

- a wired telephone interface 18 (fig. 1) electrically coupled to a wired telephone network;

- a current source 25 (fig. 1); and

- a controller operative to determine whether a connection between said one or more wired telephones and said wired telephone network is operative (see col. 4, lines 54-59) wherein said controller maintains a connection with said wired telephone network and said wireless telephone network (see col. 7, lines 15-25) and, in response to determining that said connection between said one or more wired telephones and said wired network is inoperative, said controller further operative to:

 - cause said current source to deliver an electrical current to said one or more wired telephones compatible with POTS service (see col. 4, lines 60-65);

 - detect an incoming call at said wireless radio (see col. 6, lines 21-26);

 - provide a ring signal through said wired telephone interface operative to ring said one or more wired telephones in response to detecting said incoming telephone call (see col. 6, lines 39-43); and

in response to determining that a one of said one or more wired telephones has been placed in an off hook state, said controller operative to establish a communications channel between said wired telephone interface and said wireless radio, thereby permitting said incoming telephone call to be received on said one of said wired telephones placed in an off hook state (see col. 6, lines 49-60).

Referring to Claim 15, Fintel teaches a method for providing a gateway between one or more wired telephones and a wireless telephone network 30 (fig. 1) wherein said one or more wired telephones 18 (fig. 1) are directly connected to a wired home network 16 (fig. 1), comprising:

determining whether a connection between said one or more wired telephones directly connected to said wired home network and a wired telephone network is operative (see col. 4, lines 54-59) wherein said gateway maintains a connection with said wired telephone network and said wireless telephone network (see col. 7, lines 15-25);

in response to determining that said connection between said one or more wired telephones and said wired network is inoperative,

delivering an electrical current to said one or more wired telephones compatible with POTS service (see col. 4, lines 60-65);

detecting an incoming telephone call at a wireless radio (see col. 6, lines 21-26);

providing a ring signal to said one or more wired telephones in response to detecting said incoming telephone call (see col. 6, lines 39-43); and

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in response to determining that a one of said one or more wired telephones has been placed in an off hook state, establishing a communications channel between said one or more wired telephones and said wireless telephone network, thereby permitting said incoming telephone call to be received on said one of said wired telephones placed in an off hook state (see col. 6, lines 49-60).

Referring to Claim 19, Fintel teaches a computer-controlled apparatus 8 (fig. 1) for providing a gateway between a wired home telephone network and a wireless telephone network, said apparatus operative to:

provide a first mode of operation in which said apparatus is operative to monitor an operational status of a wired telephone network and to route a telephone call made from said wired home telephone network via a wired telephone directly connected to said wired home telephone network through said wireless telephone network in response to determining that said wired telephone network is not operational while maintaining an inoperative connection with said wired telephone network (see col. 7, lines 15-25); and

provide a second mode of operation in which said apparatus is operative to monitor an operational status of said wireless telephone network and to route a telephone call made from said wired home telephone network through said wired telephone network in response to determining that said wireless telephone network is not operational while maintaining an inoperative connection with said wireless telephone network (see col. 7, lines 4-14).

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Referring to Claims 2, 12, and 16, Fintel also teaches determining whether one of said one or more wired telephones has been placed in an off hook state (see 152 in fig. 5);

collecting one or more dialed digits from said one of said one or more wired telephones placed in an off hook state (see 154 in fig. 5);

instructing said wireless radio to establish an outgoing telephone call over said wireless telephone network utilizing said dialed digits (see 158 in fig. 5); and

to establish a communications channel between said wired telephone interface and said wireless radio, thereby permitting said outgoing telephone call to be placed on said one of said wired telephones placed in an off hook state (see 162 in fig. 5).

Referring to Claim 3, Fintel also teaches delivering an electrical current to said one or more wired telephones compatible with POTS service (see col. 4, lines 60-65).

Referring to Claims 4, 8, 13, and 17, Fintel also teaches said wired telephone interface operative to deliver a dial tone signal to said one or more wired telephones in response to determining that a one of said one or more wired telephones has been placed in an off hook state (see col. 2, lines 35-41).

Referring to Claims 5, 9, and 14, Fintel also teaches determining whether said wireless communications link exists between said wireless radio and said wireless telephone network (see col. 2, lines 19-26); and

in response to determining that said wireless communications link does not exist, to electrically connect said wired telephone interface and said wired network interface, thereby electrically connecting said one or more wired telephones to said wired

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telephone network so that telephone calls placed on said one or more wired telephones will be placed over said wired telephone network (see col. 2, lines 41-49), wherein said apparatus is located between said wired home telephone network and said wired telephone network (see fig. 1).

Referring to Claim 7, Fintel also teaches delivering an electrical current to said wired telephone compatible with POTS service to provide ring signals to said wired telephone (see col. 4, lines 60-65);

determining if said wired telephone has been placed in an off hook state (see 152 in fig. 5);

in response to determining that said wired telephone has been placed in an off hook state, receiving one or more dialed digits from said wired telephone (see 154 fig. 5);

placing an outgoing wireless telephone call over said wireless telephone network using said dialed digits (see 158 in fig. 5); and

converting signals associated with said outgoing wireless telephone call to a format compatible with said wired telephone and converting signals received at said wired telephone to a format compatible with said wireless telephone network, thereby permitting said outgoing telephone call to be placed and conducted on said wired telephone (see 162 in fig. 5).

Referring to Claim 22, Fintel also teaches at least one of a multi-line display and a keypad utilized for programming said apparatus (see col. 8, lines 26-31).

Referring to Claim 23, Fintel also teaches said multi-line display displaying at least one of call progress indicators and configuration information (see col. 8, lines 29-31).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 10, 18, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fintel in view of Schornack (US 5,946,616 "cited in IDS").

Referring to Claims 10 and 18, Fintel also teaches determining whether a valid communications link has been reestablished over said wireless telephone network (see 160 in fig. 5).

Fintel does not teach that in response to determining that a valid communications link has been reestablished over said wireless telephone network, electrically disconnecting said wired telephone from said wired telephone network. Schornack teaches that in response to determining that a valid communications link has been reestablished over said wireless telephone network, electrically disconnecting said wired telephone from said wired telephone network (see "Cel Code" in Table 1 in col. 5). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made

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to provide the teachings of Schornack to said device to Fintel in order to better combine the mobility of a cellular phone with the connectivity of a wired phone system.

Referring to Claim 20, Schornack also teaches the first or second modes selected as a mode of operation for said computer-controlled apparatus, and wherein said mode of operation is selected based upon a user-specified schedule (see col. 4, lines 59-67).

Referring to Claim 21, Schornack also teaches the first or second modes selected as a mode of operation for said computer-controlled apparatus, and wherein said mode of operation is selected based upon dialed digits collected from a wired telephone connected to said wired home telephone network (see col. 4, lines 49-50).

Response to Arguments

6. Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eugene Yun whose telephone number is (703) 305-2689. The examiner can normally be reached on 8:30am-5:30pm Alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on (703) 308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


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Eugene Yun
Examiner
Art Unit 2682

EY


LEE NGUYEN
PRIMARY EXAMINER